IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Matti MYYRY *et al.*	Confirmation No.:	8108
Application No.:	10/518,520	Examiner:	Zhiyu Lu
Filed:	December 21, 2004	Group Art Unit:	2618

For: MECHANISM FOR ESTABLISHING A COMMUNICATIONS GROUP

Commissioner for Patents
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants respectfully request a pre-appeal brief review of the rejections imposed in the Office Action dated November 23, 2009, for at least the following clear errors.

I. SUMMARY

The claimed inventions employ a first communications network/medium to exchange group member information, and then carry out the group communication over a second/mobile communications network. By requesting group participant ID information to be electronically set up by a master user equipment via the first communication medium/network, the claimed inventions avoid the inconvenience and burden caused by the conventional approach of manually entering the list of people/equipments.

II. REJECTIONS:

1. Claims 31, 32, 51, 52, and 62 through 64 were rejected under the first paragraph of 35 U.S.C. §112, for lack of adequate descriptive support.

2. Claims 31 through 43, 45 through 54, 61 through 73, 76, and 77 were rejected under 35 U.S.C. §102(e) an being anticipated by *Kotzin* (US 7,002,942).

3. Claim 44 was rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Kotzin* in view of *Jamieson et al.* (US 2002/0034959).

4. Claims 74 and 75 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon *Kotzin* in view of *Randall et al.* (US 7,248,677).

III. ARGUMENT

1. The Examiner's rejection of claims 31, 32, 51, 52, and 62 through 64 under the first paragraph of 35 U.S.C. §112 is factually flawed, because there is adequate descriptive support in the originally-filed disclosure for the claim feature of "establishing the group communication in the second communications network" in these claims.

Literal support is not required by the statute. *Rochester,* 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.,* 119 F.3d 1559, 1566-67 (Fed.Cir.1997). An applicant need not utilize any particular form of disclosure to describe the subject matter claimed; the description need only allow persons of ordinary skill in the art to recognize that he or she invented what is claimed. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.,* 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton,* 76 F.3d 1168, 1172 (Fed.Cir.1996)).

A review of paragraphs [0003]-[0006] and [0008] of the written description of the specification reveals that the claimed inventions employ the first communications network/medium (i.e., the short-range communications medium) to exchange group member information to avoid either manually entering by a master user the list of people/equipments of a new group or exchanging e-business cards, thereby establishing the group communication in the second/mobile communications network/medium (i.e., primary communications medium of the communications network). In particular, paragraph [0008] recites "the invention is based on the idea of establishing a communications group in **a communications network** by sending from master user equipment to at least one slave user equipment via a communications medium, preferably **a short-range communications medium that is separate from the primary communications medium of the communications network.**" These paragraphs clearly provide adequate descriptive support for "establishing the group communication in the second communications network".

In addition, canceled original claims 1 through 30, which are part of the original disclosure, such as claims 25 and 30, referred to the second communications network as the (mobile) communications network, while referred to the first communications network/medium strictly as the short-range communications medium. In particular, Claim 25 recited that "a

plurality of user equipment each including a group **communications capability in the mobile communications network**, and a transceiver for **further** communication over a short-range communications medium", "at least one user equipment being configured to operate as master user equipment (UEA) and to send (2-4,2-5) a request to at least one slave user equipment (UEB, UEC) over the short-range communications medium prompting the user of the slave user equipment (UEB, UEC) to send user information **for group establishment in the mobile communications network"**. Claim 30 recited "sending advertisements to the group members **over the communications network."** Giving claims 25 and 30 the broadest reasonable interpretation consistent with the specification, such advertisements to the group members constitute group communication over the second/mobile communications network. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

Furthermore, as acknowledged by the Examiner on page 2, lines 13-15 of the Office Action, the Abstract supports "initiating group communication in the network 2 (N2, e.g., GSM)."

The Examiner's interpretation of N2 as alternative storage is only one embodiment of the invention, which is not exclusive or inconsistent with "establishing the group communication in the second communications network". In fact, this interpretation facilitates "establishing the group communication in the second communications network," since the collected group information stored in the second communications network can be used to establish the group communication in the second communications network.

It is therefore apparent that there is clear descriptive support, at least in the Abstract, paragraphs [0003]-[0006] and [0008], and original claims 1 through 30 of the written description of the specification, for the claim feature of "establishing the group communication in the second communications network." It follows that one having ordinary skill in the art would recognize from the originally-filed disclosure that Applicants had possession of the claimed inventions at the time of filing. Applicants therefore respectfully solicit the Appeals Panel to withdraw the Examiner's rejection of claims 31, 32, 51, 52, and 62 through 64 under the first paragraph of 35 U.S.C. §112.

2. Claims 31 through 43, 45 through 54, 61 through 73, 76, and 77 are not anticipated by *Kotzin* under 35 U.S.C. §102(e).

The Examiner's misunderstanding which apparently precipitated the rejection under the first paragraph of 35 U.S.C. §112 appears to have tainted the anticipation rejection under 35 U.S.C. §102(e). That is, the Examiner's rationale is based on the flawed premise that the specification does not disclose "establishing the group communication in the second communications network." Such is not the case.

Thus, when applying *Kotzin* to the claim feature "establishing the group communication in the second communications network," the Examiner used a network 104. However, *Kotzin* merely establishes a group of close-by subscribers to exchange resources capability information (e.g., bandwidth) via the first/short-rage network, to allow communication "**with** the wireless wide area network (FIG. 1; col. 6, lines 19-35)". The communication is to facilitate one of the subscribers to communicate with the network 104, rather than any group communication among the subscribers. Applicants submit that one having ordinary skill in the art would readily recognize that the group communication in this context refers to communication among the group members. *Kotzin*'s wireless apparatus, at best, communicates with each other via the short-range communication system, but not via the WAN. *Kotzin* is silent about "establishing the group communication in the second/mobile communications network." Accordingly, there is no factual basis for the Examiner's determination that *Kotzin* discloses, or even suggests, "establishing the group communication in the second/mobile communications network."

Since *Kotzin* clearly does not anticipate the claimed subject matter under 35 U.S.C. §102(e), it is respectfully requested that the Appeal Brief Panel withdraw the rejection of claims 31, 32, 51, 52, and 62 through 64 under 35 U.S.C. §102(e) as anticipated by *Kotzin*.

3. Claim 44 are not obvious under 35 U.S.C. §103(a) upon *Kotzin* in view of *Jamieson,* since *Jamieson* does not provide for the deficiencies of *Kotzin*.

4. Claims 74 and 75 are not obvious under 35 U.S.C. §103(a) upon *Kotzin* in view of *Randall,* since *Randall* does not provide for the deficiencies of *Kotzin*.

IV. CONCLUSION

For the foregoing reasons, the Appeal Brief Panel is respectfully requested to withdraw each of the rejections imposed in the Office Action dated November 23, 2009

Respectfully Submitted,

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Date

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